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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,910	03/01/2004	Rainer Kropke	104035.274389	1406

826 7590 03/29/2005

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,910

Applicant(s)

KROPKE ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/1/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-24 are pending in this application filed 3/1/04, which is a continuation of PCT application filed 8/28/02, which claims priority to German application filed 9/1/01.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8, 9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Honsa (US 5,174,927).

Honsa teaches liquid detergent compositions containing iminodisuccinate sodium salt in combination with polyol such as propanediol. See col. 39-40, Examples IVH and VF. The exemplified amounts of iminodisuccinate sodium salt are 2% and 5% by weight; the exemplified amounts of propanediol are 1% and 4% by weight. See Examples above. The compositions of Honsa may contain other polyols such as those

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having from 2 to 6 carbon atoms and from 2 to 6 hydroxy groups (e.g. propylene glycol, ethylene glycol and glycerin). See col. 33, lines 44-48. With respect to Claims 11-13, the preamble in these claims is not given patentable weight because the body of the claim does not recite any additional ingredients. The Applicant is invited to recite essential ingredients that make the composition of claim 1 a skin care product, a face care product or a sunscreen product.

Thus, Honsa teaches each and every limitation of Claims 1-6, 8, 9 and 11-13.

4. Claims 1, 2, 5-9, 11-15, 18-22 and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by Fernandez-Kleinlein et al. (WO 02/19981), supplied by the Applicant.

Fernandez-Kleinlein et al. teach cosmetic and pharmaceutical compositions containing 0.1-95% of a chelating agent such as iminodisuccinate (acid or salt). See Abstract; p. 5, lines 23-25; p. 6, lines 24-32; p. 7, lines 1-10; p. 10, lines 10-15. The compositions of Fernandez-Kleinlein et al. may contain moisturizing agents such as butylene glycol, glycerin, sorbitol, etc. See p. 12, lines 28-34. Fernandez-Kleinlein et al. exemplify a composition containing 13% of iminodisuccinate and 5% of polyethylene glycol. See p. 20, Example 10. The compositions of Fernandez-Kleinlein et al. are applied to the skin for the treatment of various skin conditions such as eczema, irritation and skin dryness. See p. 16, lines 13-20. With respect to Claim 24, the recitation "increasing the skin-moisturizing action of a polyol in a cosmetic or dermatological formulation" is inherent in the reference because the reference teaches

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the claimed method step, i.e. "adding to the cosmetic or dermatological formulation iminodisuccinic acid or a salt thereof."

Thus, Fernandez-Kleinlein et al. teach each and every limitation of Claims 1, 2, 5-9, 11-15, 18-22 and 24.

5. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honsa (US 5,174,927) in view of Finch et al. (US 6,395,696).

Honsa applied as above. While teaching iminodisuccinate sodium salt, Honsa does not explicitly teach the acid. However, Finch et al. teach using either iminodisuccinic acid or iminodisuccinate sodium salt for the same purpose, i.e. as builders, in detergent compositions. See col. 2, lines 10-32, 49-52. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Honsa such that to use iminodisuccinic acid instead of iminodisuccinate sodium salt. One having ordinary skill in the art would have a

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reasonable expectation of obtaining the same cleaning effect as set forth in the Honsa reference because these compounds are used interchangeably for the same art-recognized purpose as suggested by Finch et al. Selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Alternatively, nothing unobvious is seen in substituting the known salt for the free acid, as taught by Finch et al., since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honsa (US 5,174,927) in view of Weber (US 4,169,817).

Honsa applied as above. Additionally, Honsa's detergent compositions may contain enzymes. See col. 31. While teaching the compositions containing polyols having from 2 to 6 carbon atoms and from 2 to 6 hydroxy groups (e.g. propanediol, glycerin, propylene glycol or ethylene glycol), the reference does not explicitly teach the claimed combination of glycerin, sorbitol and butylene glycol. However, Weber teaches liquid cleaning compositions containing polyols such as glycerin, butylene glycol and/or sorbitol as enzyme stabilizing agents. See col. 3, lines 11-19. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the detergent compositions of Honsa such that to employ butylene glycol and sorbitol. One having ordinary skill in the art would have been motivated to do this to

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obtain improved enzyme stability as suggested by Weber. Selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

9. Claims 3, 4, 10, 16, 17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Kleinlein et al. (WO 02/19981).

Fernandez-Kleinlein et al. applied as above. With respect to Claims 3, 4, 16 and 17, the reference does not explicitly teach the claimed concentration range. However, it exemplifies the composition containing 13% of iminodisuccinate, and broadly teaches the concentration of chelating agent ranging from 0.1 to 95%, preferably 0.2-90%, more preferably 0.4-85%. See p. 10, lines 10-15. Therefore, the determination of optimal or workable concentration of iminodisuccinate chelating agent within the reference's broad range by routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired moisturizing properties of the composition. With respect to Claims 10 and 23, the reference teaches the claimed polyols but fails to explicitly teach the claimed combination. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine more than one polyol in order to achieve the desired moisturizing effect. The determination of optimal or workable combination of moisturizers within the

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reference's generic disclosure by routine experimentation is obvious absent showing of criticality of the claimed combination.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,489,280; US 2001/0021711; US 2003/0026820; US 2003/0037384; WO 00/70004 A1.

11. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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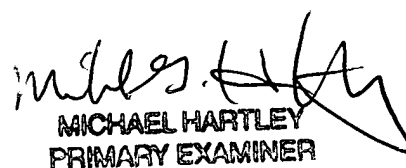
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ml

3/17/05


MICHAEL HARTLEY
PRIMARY EXAMINER